

REMARKS/ARGUMENTS

In response to the restriction requirement of March 30, 2006, applicants elect the claims of Group 1, claims 1-5, with traverse. In response to the further restriction, applicants elect the PDZ protein TIP1 and the PL protein LPAP (see Claim 5) with traverse. In response to the election of species, applicants elect the entire protein sequence of the binding pair and all elected claims are readable thereon. The restriction requirement is traversed as to the division between Group I and Group II, because Groups I and II are species of a generic invention. The requirement is also traversed insofar as the election of particular PDZ and PL proteins is presented as a restriction requirement and not as an election of species requirement.

Claims 1 and 2 have been amended to more clearly claim the invention. Claims 37-41 have been added. Support for the amendments to claims 1 and 2 and new claims 37-41 can be found in the Specification and claims, for example, page 1, lines 18-24, and examples 1 and 6. As a result of the amendment and restriction requirement, Claims 1-5 and 37-41 are presented for further prosecution. Applicants reserve the right to file divisional or related applications to the claims of the non-elected groups.

Groups I and II

The present case is generally directed to methods of screening for agents that modulate immune cell signaling by modulating movement of a PDZ or a PL protein into or out of lipid rafts.

In a restriction requirement mailed March 30, 2006, the examiner divided the claims into groups designated I to VI. Claims 1-5 constituted the Groups I and II claims, because the examiner restricted modulation to, inhibition in Group I and activation in Group II. Applicants respectfully traverse on the grounds that there is no statutory basis for requiring restriction within a single claim and, at most, the examiner should have imposed an election of species requirement.

Requirement for election of a specific PDZ and PL

In the restriction requirement mailed March 30, 2006, the examiner stated that hundreds of GROUPS are encompassed by the claims of Groups I and II and required restriction

to ONE PDZ protein and ONE PDZ ligand protein. The examiner stated that "absent evidence to the contrary, each of the recited PDZ proteins and PDZ ligand proteins thereof is distinct since each ligands(s) to which each of the said proteins or ligand protein is specific for is not obvious over the other set of ligand(s). Therefore the instant claims 1-5 encompass hundreds of GROUPS, not species. Applicants respectfully traverse on the grounds that there is no statutory basis for requiring restriction within a single claim and, at most, the examiner should have imposed an election of species requirement.

Traverse arguments

The restriction requirement is in error because it requires division of a generic claim contrary to controlling law. The statute authorizing restriction practice, *i.e.*, 35 U.S.C. § 121, provides no legal authority to impose a restriction requirement on a single claim, even if the claim presents multiple independently patentable inventions.

The discretionary power to limit one application to one invention is no excuse at all for refusing to examine a broad generic claim--no matter how broad, which means no matter how many independently patentable inventions may fall within it. *In re Weber et al.* 198 USPQ 328, 331 (C.C.P.A. 1978) at 334.

The claims in *Weber* stood rejected on the basis that individual claims were allegedly misjoined under 35 U.S.C. § 121 as containing multiple independent and distinct inventions. The court held that 35 U.S.C. § 121 does not provide a basis for an examiner to "reject a particular *claim*" *In re Weber* at 332 (emphasis in the original). The court explained that:

As a general proposition, an applicant has a right to have each claim examined on the merits. If an applicant submits a number of claims, it may well be that pursuant to a proper restriction requirement, those claims will be dispersed to a number of applications. Such action would not affect the rights of the applicant eventually to have each of the claims examined in the form he considers to best define his invention. If, however, a single claim is required to be divided up and presented in several applications, that claim would never be considered on the merits. The totality of the resulting fragmentary claims would not necessarily be the equivalent of the original claim. Further, since

the subgenera would be defined by the examiner, rather than by the applicant, it is not inconceivable that a number of the fragments would not be described in the specification.

Instead of imposing a restriction requirement on a single claim, the Patent Office may limit initial examination to a reasonable number of species encompassed by the claim.

See 37 C.F.R. § 1.146. This practice strikes an appropriate balance between the concerns of the patent office regarding administrative concerns and unduly burdensome examination, and the clear constitutional and statutory rights of an inventor to claim an invention as it is contemplated.

See MPEP (Eighth Edition August 2001, Revision 1, February 2003) at § 803.02; *see also* *In re Wolfrum*, 179 USPQ 620 (CCPA 1973); and, *In re Kuehl*, 177 USPQ 250 (CCPA 1973). The MPEP states that an unduly extensive and burdensome search of a generic claim justifies an election of species requirement, but says nothing about a restriction requirement of a generic claim (MPEP § 808.01(a)). It is acknowledged that this section of the MPEP is headed "Restriction--Markush Claims." Nevertheless, the text is explicit that an election of species is intended.

A Markush-type claim can include independent and distinct inventions. This is true where two or more of the members are so unrelated and diverse that a prior art reference anticipating the claim with respect to one of the members would not render the claim obvious under 35 U.S.C. 102 with respect to the other members. In applications containing claims of that nature, the examiner may require *a provisional election of a single species* prior to examination on the merits.

MPEP § 803.02 (emphasis supplied).

Also, the MPEP should be construed as being consistent with the case law of *In re Weber* and *In re Haas*, as reaffirmed by *In re Harnisch*, that 35 U.S.C. 121 cannot be used to reject a single claim. Unlike a restriction requirement, a species election does not preclude an applicant from pursuing the original form of a claim in subsequent prosecution, nor does it force an applicant to file multiple divisional applications which are incapable of capturing the intended scope of the application.

Here, the restriction of Claims 1-5 into two groups separated by the type of modulation: inhibition vs activation is inappropriate. Further the restriction of both groups into "hundreds of groups" by virtue of the specific PDZ/PL binding pair is contrary to the controlling case law of *In re Weber* as subsequently re-affirmed by *In re Harnisch*. Even if applicant was to pursue hundreds of divisional applications, the aggregate scope of the resulting claims would not be the same as that of present claim 1. The examiner's rationale that individual claims contain many patentably distinct inventions is "no excuse at all" for purporting to restrict individual claims. *In re Weber* at 334. The appropriate remedy for an unduly extensive and burdensome search is an election of species requirement. MPEP § 808.01(a).

If the examiner believes a telephone conference would expedite prosecution of this application, please telephone the undersigned at 650-326-2400.

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Respectfully submitted,



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